UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,469	10/28/2003	Lynne C. Haynes	67608	5614

37138 7590 12/28/2006

THADDIUS J. CARVIS
102 NORTH KING STREET
LEESBURG, VA 20176

EXAMINER	
CHAWLA, JYOTI	
ART UNIT	**PAPER NUMBER**
1761	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,469	HAYNES ET AL.	
	Examiner	Art Unit	
	Jyoti Chawla	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The Amendment filed October 11, 2006 has been entered. Claims 1, 5, and 16-20 have been amended. Claims 1-20 are pending and examined in the current application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 16, recite "processing is *effective to cause* less trans-to-cis isomerization in the gelatin than would occur *in prior art* processing wherein gelatin and sucrose are mixed after forming solutions of each." The claim as recited is indefinite, as it is not clear as to what references are encompassed by the phrase " prior art", i.e., whether all other prior art or only specific prior art is to be considered.

Furthermore phrases "Effective to cause", as recited in claims 1 and 16 are also indefinite. It is unclear whether a process step-which is "effective to cause" a result - would actually cause such a result or not in the presence of other variables, such as temperature, moisture, etc. Thus the prior art reading upon the process as instantly claimed would be expected to be "effective" in the same way as instantly claimed.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Pintauro et al (US 3067036).

The references and rejection are incorporated herein and as cited in the office action mailed July 11, 2006.

Regarding the amendments to claims 16-20, Pintauro teaches the blend consisting essentially of sugar and gelatin, where the particle sizes of sugar and gelatin are such that 100% of the particles pass through size 40 mesh (Column 7, lines 5-11 and lines 25-44), as claimed by the applicant in claims 17-20. Sugar and gelatin in the composition taught by Pintauro are present in the ratio of about 10:1 which falls within the range (4:1 to 20:1) as claimed by the applicant in claim 16.

Regarding the amendment to claim 16, where "A dry blend of sugar and gelatin is suitable for processing by a process entailing …", Pintauro reference teaches a dry blend of sugar and gelatin, which consists essentially of sugar and gelatin (97.04%, Column 7, Example 1) and the rest of the claim recites the intended use of the dry blend of gelatin and sugar. The recitation that "dry blend of sugar and gelatin is suitable for processing…" is not a positive limitation and only requires the ability to perform. Thus the recitation of intended use of a known product does not make a claim to the previously known product patentable.

Thus Pintauro anticipates applicant's claims 16-20 as recited by the applicant, absent any clear and convincing evidence and/or arguments to the contrary.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 1, 2, 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zietlow et al (US 6432460 B1) in view of Addesso (US 3362830).

The references and rejection are incorporated herein and as cited in the office action mailed July 11, 2006.

Regarding the amendments to claim 1, step c), the new limitation has been addressed in the previous office action under the rejection of claim 8. Also see Zietlow 6432460, Column 4, lines 12-16, Column 112, lines 51-52.

The added limitation to claim 1 g) recites "aerating the confection composition, wherein the processing is *effective to cause* less trans-to-cis isomerization in the gelatin than would occur *in prior art* processing wherein gelatin and sucrose are mixed after forming solutions of each". This is not a positive limitation and only requires the ability to perform. Furthermore, it is noted that trans-to-cis isomerization occurs as a result of abusive temperatures during processing and is indicative of loss of gel strength. Zietlow does not specifically state reduced trans-to-cis isomerization, however the reference does teach that gelatin exhibits degradation and loss of its foam structuring

properties, i.e., loss of gel strength, when subjected to higher temperatures in hot liquids. Zietlow further teaches that when gelatin is added to the liquids that are at a temperature in the range of 26-85 ^{0}C, desirable properties of gelatin are retained, i.e., gel strength, foaming etc (Column 11, lines 20-25). Thus Zietlow teaches that the temperature of liquid at the time of addition of gelatin is important in reduction of degradation due to loss of foaming structuring properties, i.e., reduction in trans-to-cis isomerization in gelatin. It is noted that the gel forming properties of gelatin reduce when gelatin is exposed to very high temperatures after being hydrated, irrespective of whether gelatin is hydrated and then mixed with sugar syrup or made into a dry mix with sugar and then hydrated with sugar syrup. Therefore, based on the above explanation, the Zietlow reference does teach aerating the confection wherein less trans-to-cis isomerization of gelatin occurs as recited in the amended claim 1 g).

Furthermore, Applicant is reminded that where the claimed and prior art products are similar in composition, or are produced by similar processes, a prima facie case of obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

(B) Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zietlow and Addesso as applied to claims 1,2, 5-15, further in view of Gajewski (US 4251561).

The references and rejection are incorporated herein and as cited in the office action mailed July 11, 2006.

(C) Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addesso (US 3362830), in view of Zietlow et al (US 6432460 B1).

The references and rejection are incorporated herein and as cited in the office action mailed July 11, 2006.

Regarding the amendment to claim 16, where "A dry blend of sugar and gelatin is suitable for processing by a process entailing ...", Pintauro reference teaches a dry blend of sugar and gelatin, which consists essentially of sugar and gelatin (97.04%, Column 7, Example 1) and the rest of the claim recites the intended use of the dry blend of gelatin and sugar. The recitation that "dry blend of sugar and gelatin is suitable for processing..." is not a positive limitation and only requires the ability to perform. Thus the recitation of intended use of a known product does not make a claim to the previously known product patentable, absent any clear and convincing evidence and/or arguments to the contrary.

Response to Arguments

Applicant's arguments filed October 11, 2006 have been fully considered but they are not persuasive.

I) Regarding the relevance of the Levine reference, as stated in pages 7-9 of the remarks, the applicant states that the dry mix minimizes the Bloom loss, which has not been claimed in the present application. Thus applicant's remarks are not persuasive.

II) Applicant traverses the rejection of claims 16-20, as rejected by Pintauro (US 3067036) (Pages 9-10 of remarks).

Pintauro teaches a gelatin dessert composition which includes mixing dry gelatin and sucrose, i.e., sugar, both having the similar particle sizes, i.e., 100% passes through size 40 mesh (Column 7, lines 5-11 and lines 25-44), in the ratio of about 10:1 which falls within the range (4:1 to 20:1) as claimed by the applicant.

In response to applicant's argument that Pintauro does not make the dry blend of gelatin and sugar for the same purpose as the applicant, the applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. And since the dry blend of sugar and gelatin taught by Pintauro, consists essentially of gelatin and sugar (97.04%) (Column 7, Example 1), and has the weight ratio and particle size in the range claimed

by the applicant, the dry blend of sugar and gelatin as taught by Pintauro can be hydrated as claimed, thus Pintauro teaches the invention as claimed in claims 16-20.

III) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "present invention helps minimize bloom" (Remarks, page 9); "the purpose of the present invention is to facilitate hydration of gelatin" (Remarks, Page 10)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

IV) Regarding applicant's traversal of the obviousness rejection of claims 1, 2, 5-15 by Zietlow in view of Addesso (Pages 10-12, Remarks), applicant is referred to the rejection above and the prior office action dated July 11, 2006.
Regarding the argument that Zietlow does not teach a dry blend of sugar and gelatin, which is taught by Addesso (Column 2lines 35-45; Column 4, lines 5-10 and Column 5, lines 5-10) as discussed in the previous office action. Similarly, the applicant argues that Addesso does not teach the process steps as instantly claimed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

V) Applicant argues about the unexpected results without showing any proof verifying the unexpected results. Furthermore, regarding the unexpected result of preserving the preserving the trans (gel forming) configuration, applicant is referred to the office action above where Zietlow teaches that temperatures in the range of 26-85 ^{0}C retain good gel forming qualities without causing deterioration (Column 11, lines 20-25). It is noted that trans-to-cis isomerization occurs as a result of abusive temperatures during processing (Remarks, page 9, paragraph 1). Thus the gel forming properties of gelatin reduce when gelatin is exposed to very high temperatures after being hydrated, irrespective of whether gelatin is hydrated and then mixed with sugar syrup or made into a dry mix with sugar and then hydrated with sugar syrup (as instantly claimed). Therefore, it would have been obvious to one of ordinary skill in the art that gelatin's gel-forming properties are reduced when it is heated in a liquid to very high temperatures, such as above 100 ^{0}C. Thus the unexpected results as claimed by the applicant would not have been unexpected.

VI) In response to applicant's argument that there is no suggestion to combine the Zietlow, Addesso and Gajewski references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992). Furthermore, since the applicant does not point to any specific motivation, the applicants are referred to the motivations for combining the following references that have been provided in the office action dated July 11, 2006 .

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jyoti Chawla
Examiner
Art Unit 1761

KEITH HENDRICKS
PRIMARY EXAMINER